

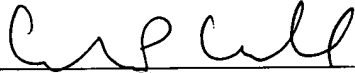
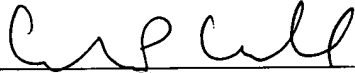
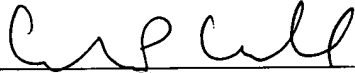
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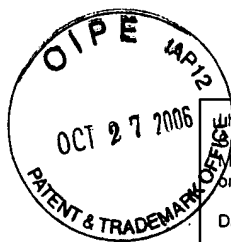
PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SMCY-P01-104											
	Application Number 10/671,903	Filed September 26, 2003											
	First Named Inventor Richard F. Gladney												
	Art Unit 3673	Examiner S. Singh											
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant /inventor.</td><td rowspan="2"> _____ Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,776</td><td>_____ Christopher Paul Carroll Typed or printed name</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td><td>_____ (617) 951-7000 Telephone number</td></tr><tr><td></td><td>_____ October 25, 2006 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant /inventor.	 _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,776	_____ Christopher Paul Carroll Typed or printed name	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	_____ (617) 951-7000 Telephone number		_____ October 25, 2006 Date	<input checked="" type="checkbox"/> *Total of 1 forms are submitted.
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 25, 2006

Signature:

(Judith A. Herrick)

Docket No.: SMCY-P01-104
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Richard F. Gladney

Confirmation No.: 8016

Application No.: 10/671,903

Art Unit: 3673

Filed: September 26, 2003

Examiner: Sunil Singh

For: MATTRESS CENTER RIDGE
COMPENSATOR

PRE-APPEAL BRIEF REASONS FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action (the "Action") pending in the above referenced application, Applicant requests a panel review of the pending rejections prior to proceeding with the full appeals process. Applicant encloses the requisite Notice of Appeal along with the remarks set forth below.

The application includes 27 claims, six of which (claims 1, 14, 18, 20, 21, and 23) are independent. Claims 14-17 have been withdrawn. Claims 1, 2, 4, 6-8, 18-22, 24-27, and 29 stand rejected under 35 U.S.C. 103(a) over the combination of U.S. Patent No. 5,579,549 ("Selman et al.") or U.S. Patent No. 6,041,459 ("Nunez et al.") in view of U.S. Patent No. 5,077,849 ("Farley '849") or U.S. Patent No. 6,003,179 ("Farley '179"). Claims 9-11 are rejected under 35 U.S.C. 103(a) in further view of Klancnik. Claims 9 and 12-13 are rejected under 35 U.S.C. 103(a) in further view of Talbert et al. or Bonaddio et al. or Fultz et al. Claims 1, 2, 4, 6, 13, and 18-29 stand rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Claims 1, 2, 6, 9, and 18-28 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,859,505 ("Jarvis"). Claims 4 and 29 stand rejected 35 U.S.C. 103(a) as being unpatentable over Jarvis. Applicant respectfully disagrees and asserts that the above rejections are based on clear errors.

I. The § 103 Rejection of Claims 1, 2, 4, 6-8, 18-22, 24-27, and 29 is based on clear errors and should be withdrawn

a. The Examiner's Interpretation Includes a Modification of the Prior Art that is not Identified in the Rejection

The Examiner has repeatedly asserted that "there is no structure precluding the examiner's interpretation of what is the head portion and the foot portion." (See Final Office Action, page 6, See Office Action, mailed 10/7/05, page 6). However, there is no explicit or implied teaching of any kind, in any of the references, to support the "examiner's interpretation." All of the prior art references explicitly define "head" and "foot" sections. One of ordinary skill at the time would clearly and rationally understand that the "head" and "foot" sections must correspond to the normal and customary position of the head and feet of a user laying on a bed. The only support for the "examiner's interpretation" is provided by the Examiner, himself, in the Marked-up drawings attached to the Final Office Action and Office Action, mailed 10/7/05. Because it is clearly improper to redefine the meaning of the elements, i.e., the "head section" and "foot section," as defined in the prior art, the "examiner's interpretation" can only be characterized as a modification of the prior art. The Examiner apparently admits that a modification of the prior art is required by the following statement:

For example, if one were to lay transversely on a bed, then the portion of the bed where the users head lies would be considered the head portion and the portion of the bed where the users feet lies would be considered the foot portion. (See Final Office Action, page 6)

By the Examiner's own admission, the "examiner's interpretation" involves an additional process step, not disclosed in any of the prior art references, whereby "one" must "lay transversely on a bed." It was clear error for the Examiner to not properly characterize the "examiner's interpretation" as a modification of the prior art references. Because none of the prior art references teach or suggest such a modification, the Examiner could only base this modification on the knowledge of one of ordinary skill at the time. Therefore, the Examiner's § 103 Rejection is improper because it does not properly reference one of ordinary skill in the art in combination with Selman et al., Nunez et al., Farley '849, and Farley '179.

b. The Examiner's Interpretation Renders all of the Prior Art Unsatisfactory for their Intended Purposes

The "examiner's interpretation" is essentially the same type of interpretation that the CAFC rejected in *In re Gorden* (See *In re Gorden*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). In the Final Office Action on page 7, the Examiner stated "...such limitation depends on ones perspective orientation, see attached drawings of orientation considered by examiner as "head portion" and "foot portion" etc..." As stated by the Applicants on page 12 in the Office Action Response, dated 3/7/2006, *In re Gorden* rejects a prima facie case of obviousness based on a modification of the prior art created by viewing the prior art references from "one direction" (i.e., one perspective) and the claimed invention (e.g., claims 1, 2, 4, 6-8, 18-22, 24-27, and 29) from another direction. By changing the perspective position of the "head portion" and "foot portion," the Examiner admits that his prima facie case of obviousness is based on his "perspective orientation" which he illustrates in his own Marked-up drawings attached to the Final Office Action. By changing the perspective position of the "head portion" and "foot portion," the prior art references Selman et al., Nunez et al., Farley '849, and Farley '179 are rendered unsatisfactory for their intended purposes. For example, based on the "examiner's interpretation," the "center portion 102" of Selman et al. would no longer be able to independently "bear the most weight during sleeping" (See Selman et al., col. 1, line 29) because a user must now lay in parallel to the "center portion 102" as shown in the Examiner's Marked-up drawings. In other words, the "center portion 102" would no longer independently support the heavier mid-section of a person while the "head portion 104" would no longer independently support the upper area or head of a person and while the "foot portion 106" would no longer independently support the lower area or feet of a person while laying on the "pad 100."

Because the "examiner's interpretation" renders the Selman et al., Nunez et al., Farley '849, and Farley '179 unsatisfactory for their intended purposes, the § 103 Rejection of claims 1, 2, 4, 6-8, 18-22, 24-27, and 29 should be withdrawn.

c. There is nothing in the Prior Art to Suggest the Desirability of the Examiner's Interpretation

As discussed on page 13 of the Response to Office Action, dated 3/7/2006, "the prior art must suggest the desirability of the claimed invention" (See MPEP §2143.01). Only the Examiner has suggested a desirability of the claimed invention by modifying Fig. 1 of Selman et al. There is no explicit or implied teaching of any kind, in any of the references, to support the desirability of the "examiner's interpretation." Because the Examiner did not recognize that the "examiner's interpretation" is a modification that could only be made by one of ordinary skill,

the Examiner failed to inquire whether it would have been obvious to one of ordinary skill to make such a modification. Thus, the § 103 Rejection of claims 1, 2, 4, 6-8, 18-22, 24-27, and 29 should be withdrawn.

d. The Examiner's Interpretation is Based Impermissible Hindsight Reasoning

Contrary to the assertion that the "examiner never proposed to rotate anything" (See Final Office Action, page 7), the "examiner's interpretation" includes a modification of Fig. 1 of Selman et al. where the "perspective orientation" of the "head portion" and "foot portion" are conceptually rotated to correspond to the sides of the pad 100. It is the Examiner alone, and no other reference, that teaches, suggests, or provides motivation for this modification. Thus, the "examiner's interpretation" is based on impermissible hindsight reasoning and, therefore, the § 103 Rejection of claims 1, 2, 4, 6-8, 18-22, 24-27, and 29 should be withdrawn.

II. The § 112 Rejection of Claims 1, 2, 4, 6,-13, and 18-29 is based on clear errors and should be withdrawn

In the Final Office Action on page 2, the Examiner asserts that the negative limitation "other than a single air bladder" in base claims 1, 18, 20, 21, and 23 "was never described in the originally filed disclosure, and therefore, it constitutes new matter."

However, MPEP § 2173.05(1) states "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." More particularly, *In re Johnson* states "[the] specification, having described the whole, necessarily describes the part remaining" (See *In re Johnson*, 558 F.2d 10008, 1019, 194 USPQ 187, 196 (CCPA 1977)).

The Application, as originally filed, defines "any material or materials" as "including open coils, pocket coils, a monolithic or composite foam (such as viscoelastic foam), fluids or gasses in one or more bladders, and so forth, or any combination of these" (See Application, page 7, para. 22). The Application, as originally filed, also discloses "firmer materials (for, e.g., foam or air bladders), and so forth" (See Application, page 7, para. 22). Base claim 1, as originally filed also recites "a center region traversing the mattress from the head end to the foot end, the center region including one or more materials that mitigate the emergence of a center ridge over repeated uses of the mattress." Thus, the Application, as originally filed, includes a single air bladder as an alternative element.

Because the Application as originally filed, positively recites one or more bladders including air bladders (i.e., a single air bladder) as an alternative element, the negative limitation "other than a single air bladder," as recited in base claims 1, 18, 20, 21, and 23 does not

constitute new matter. Therefore, the §112 Rejection of claims 1, 2, 4, 6-13, and 18-29 should be withdrawn.

III. The § 102 Rejection of Claims 1, 2, 6, 9, 18-28 is based on clear errors and should be withdrawn

Based on the discussion in Section II above, Jarvis does not teach or suggest "including one or more materials other than a single air bladder" as recited in base claims 1, 18, 20, 21, and 23. Because Jarvis et al. does not teach all of the elements of base claims 1, 18, 20, 21, and 23, the §102 Rejection of base claims 1, 18, 20, 21, and 23 should be withdrawn.

Because claims 2, 6, 9, 19, 22, and 24-28 depend from, and are limited by, base claims 1, 21, and 23, the §102 Rejection of these claims should be withdrawn.

IV. Other § 103 Rejections are based on clear errors and should be withdrawn

Based on the discussion in Section II above, the §103 rejection of claims 4 and 29 should be withdrawn because Jarvis does not teach all of the elements of claims 4 and 29.

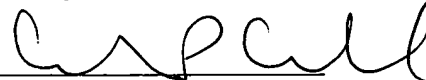
Based on the discussion in Section I above, the §103 rejection of claims 9-11 should be withdrawn because the addition of Klancnik does not support a prima facie case of obviousness.

Based on the discussion in Section I above, the §103 rejection of claims 9 and 12-13 should be withdrawn because the addition of Talbert et al., Bonaddio et al. or Fultz et al. do not support a prima facie case of obviousness.

Applicant believes no fee is due with this response other than as reflected on the enclosed Fee Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. SMCY-P01-104 from which the undersigned is authorized to draw.

Dated: October 25, 2006

Respectfully submitted,

By 

Christopher P. Carroll

Registration No.: 55,776

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